

2662

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

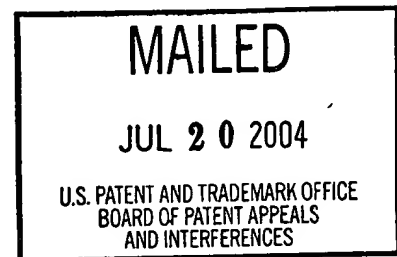
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte SRINATH HOSUR, and ANAND G. DABAK

Appeal No. 2003-0948
Application No. 09/224,401

ON BRIEF



Before JERRY SMITH, RUGGIERO, and MACDONALD, **Administrative Patent Judges.**

MACDONALD, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-8 and 10-28. Claim 9 was objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form. Claims 29-45 are allowed.

Invention

Appellants' invention relates to wideband code division multiple access (WCDMA) for a communication system and more particularly to power control with space-time transmission diversity for WCDMA signals. (Appellants'

specification, page 1, lines 5-7) A measurement circuit receives a first input signal from a first antenna and a second input signal from a second antenna. The measurement circuit produces an output signal corresponding to the magnitude of the first and second signals. A control circuit produces a control signal based on the output signal and a reference signal. (specification, page 4, lines 22-28)

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A circuit, comprising:

a measurement circuit coupled to receive a first input signal from a first antenna of a transmitter and a coupled to receive a second input signal from a second antenna of the transmitter, each of the first and second input signals being transmitted at a first time, the measurement circuit producing an output signal corresponding to a magnitude of the first and second input signals; and

a control circuit coupled to receive the output signal and a reference signal, the control circuit arranged to produce a control signal at a second time in response to a comparison of the output signal and the reference signal.

References

The references relied on by the Examiner are as follows:

Gilhousen et al (Gilhousen)	5,056,109	Oct. 8, 1991
Sousa et al (Sousa)	5,832,044	Nov. 3, 1998
Kiyanagi et al (Kiyanagi)	6,029,056	Feb. 22, 2000 (filed Oct. 31, 1997)

Rejections At Issue

Claims 1-8, 10, and 12-28 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Gilhousen and Kiyanagi.

Claim 11 stands rejected under 35 U.S.C. § 103 as being obvious over the combination of Gilhousen, Kiyanagi, and Sousa.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 1-8 and 10-28 under 35 U.S.C. § 103.

Appellants have indicated that for purposes of this appeal the claims stand or fall together in five groupings:

Claims 1-8 and 10-16 as Group I;
Claim 9, as Group II (no longer on appeal);
Claims 17-21 as Group III;
Claims 22-24 as Group IV; and
Claims 25-28 as Group V.

¹ Appellants' filed a supplemental appeal brief on January 2, 2002, which replaced the appeal brief filed July 20, 2001. Appellants' filed a reply brief on May 29, 2002. The Examiner mailed out an office communication on November 13, 2002, which replaced the office communication of June 17, 2002, which replaced the office communication of March 25, 2002.

See pages 2-3 of the supplemental brief. Furthermore, Appellants argue each group of claims separately and explain why the claims of each group are believed to be separately patentable. See pages 3-7 of the supplemental brief and pages 3-6 of the reply brief. Appellants have fully met the requirements of 37 C.F.R. § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellants' filing of the brief. 37 C.F.R. § 1.192 (c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellants' claims as standing or falling together in the groups noted above, and we will treat:

Claim 1 as a representative claim of Group I;

Claim 17 as a representative claim of Group III;

Claim 22 as a representative claim of Group IV; and

Claim 25 as a representative claim of Group V.

"If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim." *In re McDaniel*, 293 F.3d 1379, 1383, 63

USPQ2d 1462, 1465 (Fed. Cir. 2002). See also **In re Watts**, 354 F.3d 1362, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

I. Whether the Rejection of Claims 1-8 and 10-16 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-8 and 10-16. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument."

Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444. “[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, Appellants argue, “there is no suggestion to combine references in either cited reference,” as “Gilhousen et al. are silent on diversity,” and “Kiyonagi et al. are silent on transmit power control.” (supplemental brief, page 6, lines 2-4) The Examiner responds, “[t]he motivation for combining the reference[s] is that the reference of Gilhousen et al. refers to fading and the reference of Kiyonagi et al teaches utilizing space diversity to overcome fading.” Appellants then argue, “[I]t is true that both references are concerned with the problem of fading,” “However, their solutions to the problem are completely different.” Appellants conclude, “[t]here is no suggestion in either reference to motivate one of ordinary skill in the art to combine Gilhousen et al with Kiyonagi et al.” We agree and find Appellants’ arguments persuasive. The record before us does not provide a motivation to combine the references to arrive at the invention of claim 1. Therefore, we will not sustain the Examiner’s rejection under 35 U.S.C. § 103.

II. Whether the Rejection of Claims 17-21 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to

one of ordinary skill in the art the obviousness of the invention as set forth in claims 17-21. Accordingly, we reverse.

With respect to independent claim 17, it shares the same rejection as claim 1. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the reason noted above with respect to claim 1.

III. Whether the Rejection of Claims 22-24 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 22-24. Accordingly, we reverse.

With respect to independent claim 22, it shares the same rejection as claim 1. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the reason noted above with respect to claim 1.

IV. Whether the Rejection of Claims 25-28 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 25-28. Accordingly, we reverse.

Other Issues

Conclusion

REVERSED

BOARD OF PATENT APPEALS AND INTERFERENCES

ARM/İlb

Texas Instruments Incorporated
P.O. Box 655474, M/S 3999
Dallas, TX 75265